

**REMARKS**

The Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and the reasons that follow.

**I. Status of the Specification and Claims**

The title of the Specification is amended to make a minor editorial changes. Present claims 1, 3-9, and 11-12 are also amended to make minor editorial changes. Non-elected claims 8-12 are withdrawn. No new matter is introduced, and claims 1-7 are currently pending to be examined on their merits.

**II. Claim Objections**

Claims 1 and 3-7 are objected to because of alleged informalities. The Applicant respectfully submits that the objections should now be moot in view of the foregoing amendments.

**III. Claim Rejection – 35 U.S.C. § 102**

Claims 1-3 and 6-7 are rejected under 35 U.S.C. § 102(a) and/or 102(e) as allegedly anticipated by U.S. Pub. No. 2003/0059657 (“Stone”) or by U.S. Pub. No. 2003/0158273 (“Kosako”). The Applicant respectfully traverses the rejection.

The teachings of Stone or Kosako cannot anticipate present independent claim 1 because neither Stone nor Kosako teach each and every element recited in claim 1. In particular, neither Stone nor Kosako discloses the applied tension F as recited in claim 1. The Office appears to be of the position that because Stone and Kosako each mentions the terms “pressure” and “laminating”, the pressure inherently anticipates the presently recited “tension.” See “Such a pressure is believed to fall in the claimed tension F kg/cm range of 0.01 and 10.” Page 5, Office Action. The Applicant respectfully traverses.

At the outset, the Office has not established any evidence to show what a “routine” or “certain” pressure would be in lamination other than what the Office “believes in.” Further, the Applicant respectfully submits that the Office has mis-analogized the term “pressure” as disclosed in Stone and Kosako with the presently recited “tension.” “Pressure” in Stone and Kosako refers to “pressing down” on something (*see* ¶[0006] of Stone and ¶[0058] of Kosako, as referenced by the Office on page 6 of the Office Action). By contrast, one of ordinary skill in the art would appreciate that “tension” refers to “pulling” something. The term “tension” in the present invention refers to a force in the longitudinal direction (machine direction) of the substrate – this is particularly evidenced in Fig. 1 and the description associated therewith in the present Specification. In effect, the pressure of Stone and Kosako refers to “compression,” which is **opposite** to the presently recited “tension.” Thus, contrary to the Office’s assertion on page 5 of the Office Action, Stone and Kosako do not teach the presently recited tensions, much less the value thereof, and, therefore, no inherency can be established.

Accordingly, at least in view of the foregoing, the teachings of Stone and Kosako cannot anticipate present claim 1 or its corresponding dependent claims.

#### **IV. Claim Rejection – 35 U.S.C. § 103**

Claims 4-5 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Stone and Kosako, in combination or alone in view of U.S. Pat. No. 6,589,690 (“Sato”) and JP 06-029032 (“Yoshio”). The Applicant respectfully traverses the rejection.

##### **(A) Current Obviousness Standard**

The U.S. Supreme Court reaffirmed the Graham factors for determining obviousness in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The Graham factors, as outlined by the Supreme Court in *Graham et al. v. John Deere Co. of Kansas City et al.*, 383 U.S. 1 (1966), are: 1) determining the scope and contents of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; 3) resolving the level of ordinary skill in the pertinent art;

and 4) evaluating evidence of secondary consideration. The Supreme Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a) and held that the proper inquiry for determining obviousness is whether the improvement is more than the predictable use of prior art elements according to their established functions. The Court noted that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed and specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was *an apparent reason to combine the known elements in the fashion claimed* by the patent at issue. To facilitate review, this analysis should be made explicit.

*KSR Int'l Co. v. Teleflex Inc.*, slip op. at 14 (emphasis added). As discussed below, the cited art cannot render the claimed invention obvious.

(B) *The present claims are non-obvious over the teachings of the cited references*

As explained in the previous section, Stone and Kosako do not teach each and every element recited in the present claims. In fact, with respect to the presently recited "tension," they teach the opposite. The teachings of Sato and Yoshio do not remedy the foregoing deficiencies.

Accordingly, one of ordinary skill in the art would not have had a reason to combine the teachings of Stone and Kosako with those of Sato and Yoshio. Even assuming, *arguendo*, that these teachings were combined, the presently claimed invention would not have resulted.

Accordingly, the Applicant respectfully requests that the rejection be withdrawn.

**CONCLUSION**

The Applicant believes that the present application is now in condition for allowance and respectfully requests favorable reconsideration of the application.

The Office is invited to contact the undersigned by telephone if a telephone interview would advance the prosecution of the present application.

The Office is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment be charged to Deposit Account No. 19-0741.

Respectfully submitted,

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